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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,488	08/13/2001	Didier Candau	016800-457	5299

7590 01/28/2004  
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EXAMINER

LAMM, MARINA

ART UNIT PAPER NUMBER

1616

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/927,488

### Applicant(s)

CANDAU, DIDIER

### Examiner

Marina Lamm

### Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13 and 15-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Acknowledgment is made of the response filed 11/17/03. Claims pending are 1-31.

Claims 5 and 14 have been withdrawn from consideration as directed to non-elected species.

#### ***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The rejection of Claims 1, 2, 6-11 and 15-31 under 35 U.S.C. 102(a) as being anticipated by Hüglin et al. (WO 99/08653) is maintained for the reasons of the record.

#### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. The rejection of Claims 1-4, 6-13 and 15-31 under 35 U.S.C. 103(a) as being unpatentable over either Hansenne or Allard et al. in view of Hüglin et al. (EP 0 775 698 = US 5,955,060) is maintained for the reasons of the record.

#### ***Response to Arguments***

5. Applicant's arguments filed 11/17/03 have been fully considered but they are not persuasive.
6. In response to the Applicant's argument that "Hüglin [WO 99/08653] does not disclose or suggest such composition containing this synergistic combination of UV filters" (see p. 3 of the Remarks), it is noted that the synergistic effect would be inherent to the compositions of Hüglin because Hüglin teaches the same compositions as claimed in the instant claims, i.e. bis(resorcinyl)triazine derivatives of the instant claims in combination with other sunscreens.

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compounds including benzotriazole derivatives. With respect to the limitations “SPF-maintaining and water remanence-enhancing amount” in Claim 1 and “sun protection factor of at least 2” in Claim 29, these limitations are inherent to the compositions of Hüglin et al. because they contain the same amounts of the UV absorbing agents. Further, the features upon which applicant relies (i.e., synergistic effect on the water remanence) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). With respect to the argument that “[t]he Examples do not exemplify the combination of at least one benzotriazole first sunscreen compound and at least one bis-resorcinyltriazine second sunscreen compound either. Instead, Examples 2 and 3 relate to formulations containing a bis-resorcinyl triazine (101 or 102) with octylmethoxycinnamate” (see p. 3 of the Remarks), it is noted that the reference’s disclosure is not limited to the examples or preferred embodiment and must be considered as a whole. Thus, considered as a whole, the reference anticipates the claimed composition because it teaches that bis-resorcinyltriazine sunscreens can be used in combination with other organic sunscreens such as compound of formula (16), which corresponds to the Applicant’s elected species (a). In response to the Applicant’s argument that “Hüglin never suggests to combine a bis-resorcinyl triazine to this compound (16) in an effective SPF-maintaining and water remanence enhancing amount” (see p. 3 of the Remarks), it is noted that the reference teaches the claimed concentrations of sunscreens, i.e. 0.1-15% by weight based on the total weight of the formulation, of a UV absorber or of a mixture of UV absorbers. See p. 12, last paragraph. Therefore, the SPF-maintaining and water remanence enhancing properties of the composition

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are inherently disclosed in the reference. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

7. With respect to the 103(a) rejection of Claims 1-4, 6-13 and 15-31 over either Hansenne or Allard et al. in view of Hüglin et al. (EP 0 775 698), the Applicant argues that “the cited references do not fairly suggest that a topically applicable sunscreen/cosmetic composition suited for the photoprotection of human skin and/or hair, having effective SPF and enhanced water remanence could be obtained.” See p. 6 of the Remarks. In response, it is noted that (1) the compositions of the prior art have SPF within the claimed range (i.e. at least 2), and (2) the limitation “water remanence-enhancing” is a term of degree and as such is not given patentable weight because no basis for comparison is disclosed or recited in the claims. Further, the Applicant argues that “one of skill in the art would not have reasonably expected that the Examiner's proposed substitution would succeed.” In response, it is noted that the Examiner never suggested that one of skill in the art would be motivated to *substitute* the sulfonic/benzimidazole compounds of Hansenne with the claimed triazines. In contrast, Hansenne teaches that the sunscreen compositions according to her invention may contain triazine derivatives *in addition to* the synergistic mixture of benzotriazole-substituted silicone compounds and sulfonic/benzimidazole compounds. See col. 7, lines 9-13 and 16. Therefore, the reference considered as a whole, suggests the desirability and thus the obviousness of combining the synergistic mixture of benzotriazole-substituted silicone compounds and sulfonic/benzimidazole compounds with triazine derivatives. The triazine derivatives of the instant claims are well known in the art of sunscreen compositions. See Hüglin et al. Thus, it

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would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use bis-resorcinyltriazine of Hüglin et al. for cosmetic sunscreen compositions of Hansenne for its art-recognized purpose and with a reasonable expectation of deriving the same cosmetic effect as set forth in the Hansenne reference. With respect to the Applicant's showing of unexpected results on pp. 7-9 of the Remarks, the results have been considered but they are not persuasive. The showing is not commensurate in scope with the claims for the following reasons: the instant claims are broader than the showing of unexpected results which is limited to the elected species of the sunscreens used in specific amounts and proportions and contained in specific formulation (i.e. carrier of Example 2). If the instant claims are amended to be commensurate in scope with the showing of unexpected results, the claims will be allowed based on the demonstrated synergistic effect.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541.

The examiner can normally be reached on Monday to Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached at (703) 308-2927.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ml

1/23/04

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
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